

**REMARKS**

The foregoing claims include those filed on February 17, 2004, plus claims 1-38, which were inadvertently omitted from the February 17, 2004 response. The following remarks are the same as those filed on February 17, 2004.

The Examiner is thanked for the careful examination of the application, and for the indication of allowable subject matter in claims 40, 42, 43, 46, 47, and 49. New claims 50-57 are added herein.

Claims 39, 41, 44, 45, and 48 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,725,781, hereinafter Röschmann, and further in view of U.S. Patent No. 5,986,531, hereinafter Carrozzi.

Claim 39 defines a Nuclear Magnetic Resonance Imaging machine comprising at least two plane surface delimiting a cavity for receiving a part of a patient, a magnet having at least one rigid shielding member movable to a position at least partially closing an open side of the cavity, wherein the shielding member comprises electrically conductive material. With regard to claim 39, the Examiner alleges that Röschmann teaches an NMR machine having at least one rigid shielding member movable to a position at least partially closing an open side of the cavity. The Examiner recognizes that Röschmann does not teach two plane surfaces delimiting a cavity and relies upon Carrozzi for the teaching of two plane surfaces delimiting the cavity. The Examiner alleges that it would have been obvious to one of ordinary skill in the art to combine the teachings of Carrozzi to construct a more versatile magnet resonance imaging device with the teachings of Röschmann so that

various body parts of the patient could be imaged with least imaging artifacts and at a reduced cost.

However, the applicant challenges the Examiner's alleged modification to combine and modify the cited prior art references. Specifically, there is no teaching or explanation by the Examiner as to how the teachings of Carrozzi would be used to image various body parts of the patient with less imaging artifacts and at a reduced cost. Specifically, the Examiner has not alleged how using the two plane surfaces of Carrozzi would improve the device disclosed by Röschmann.

Furthermore, even if the structure of Röschmann were modified to have two plane surfaces, Carrozzi teaches that a magnet of the shape disclosed in the Carrozzi reference is preferably shielded with a flexible shield, not a rigid shield. Accordingly, if one, as alleged by the Examiner, were motivated to change the shape of the Röschmann device to that taught by Carrozzi, then one would naturally also look to Carrozzi for a teaching concerning how to shield such a shape. As set forth above, and in the earlier response, Carrozzi teaches that it is preferable to shield such an arrangement with a flexible shield.

Accordingly, even if one of ordinary skill in the art would combine Carrozzi with Röschmann, the result would not be the claimed invention, which uses a rigid shielding member.

Furthermore, the Examiner cannot simply pick and choose elements from various prior art references. See *In re Dembiczak*, wherein the Court of Appeals stated, "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a

showing of the teaching or motivation to combine prior art references." 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999).

Accordingly, the applicant submits that the proposed combination is improper and should be withdrawn.

The other rejected claims 41, 44, 45, and 48 depend from claim 39, and are thus also patentable over the applied prior art at least for the reasons set forth above with respect to claim 39.

To further define the protection to which the applicant is entitled, new claims 50-57 are submitted herewith. New claim 50 defines the shielding member as being hinged to the magnet and claim 51 defines the shielding member as permanently connected to the magnet in a movable manner. Such claims also clearly distinguish over the applied prior art. In addition, new independent claim 52 has also been submitted. New claim 52 is similar to claim 39, except that it includes a "wherein" clause at the end thereof, which further states that the shielding member is connected to the magnet in a displaceable way between a first position in which the shielding member is inactively disposed so as not to cover the open side of the cavity and a second position in which the shielding member is actively engaged to shield and at least partially close the open side of the cavity. New claim 52 defines additional details of the invention that are not set forth in either Röschmann or Carrozzi. Accordingly, claim 52 is also patentable over the cited prior art. The dependent claims 53-57 depend from claim 52, and are thus also patentable.

In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: William C. Rowland  
William C. Rowland  
Registration No. 30,888

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620